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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/777,320	02/06/2001	Donald Penner	MSU 4.1-546	4169

21036 7590 03/31/2003

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EXAMINER

PRYOR, ALTON NATHANIEL

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 03/31/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/777,320

Applicant(s)
Penner et al

Examiner
Alton Pryor

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1616



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jan 10, 2003
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 7, 12-14, 18, 20-28, 40-44, 53, 55, 56, and 109 is/are pending in the application.
- 4a) Of the above, claim(s) 3, 4, 7, 12, 18, 22, 23, 27, 28, 42-44, and 56 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 13, 14, 20, 21, 24-26, 40, 41, 55, and 109 is/are rejected.
- 7) ☒ Claim(s) 53 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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I. Examiner acknowledges the incorporation of claim 54 into independent claims 1,24,25, and 109. Examiner would like to point out that he inadvertently objected to claim 54 when he intended to withdraw claim 54 from examination based on the species election. Examiner would also like to reiterate the elected invention comprising isoxaflutole plus N-(2-aminoethyl-aminopropyltrimethylsilane plus methyl trimethoxysilane is allowable. The search has been extended beyond the elected species.

Duplicate Claim Warning

Applicant is advised that should claims 1 and 24 be found allowable, claims 2 and 26 respectively will be objected to under 37 CAR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections under 35 U.S.C. 103(a)

Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,2,13,14,20,21,24-26,40,41,55,109 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoskaka et al (WO 9631121; 10/10/96) and Dahmen et al (De 19635060; 3/5/98).

Hoskaka discloses a composition comprising a herbicide and an organosilicon compound. Hoskaka teaches that the composition can be applied to foliage. See abstract. Hoskaka does not teach the composition comprising isoxaflutole. Hoskaka does not teach that the composition's retention on foliage is reduced. Dahmen teaches a herbicide composition comprising isoxaflutole. See abstract. It would have been obvious to one having ordinary skill in the art to combine the prior art compositions. One would have been motivated to do this because both prior art references individually teach herbicide compositions. Applicant provides no data to distinguish between instant invention and prior art inventions where composition remains on foliage. Therefore it would have been obvious to one having ordinary skill in the art to expect for all compositions comprising a herbicide and an organosilicon compound to have similar chemical properties including those compositions of the instant claims.

Claims 1,2,20,21,24-26,109 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hausmann et al (US 4626274; 12/2/86).

Hausmann discloses a composition comprising a number of herbicides including triazine herbicides and a spreading agent, silicon oil (organosilicon compound). Hausmann teaches that

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the composition can be applied to plants which is inclusive of plant foliage. See abstract, column 5 lines 21-37. Hausmann does not teach that the composition's retention on foliage is reduced.

Applicant provides no data to distinguish between instant invention and prior art inventions where composition remains on foliage. Therefore it would have been obvious to one having ordinary skill in the art to expect for all compositions comprising a triazine and silicon oil to have similar chemical properties including those compositions of the instant claims.

Claim objections

Claim 53 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art does not teach or suggest the instant invention comprising the silanes of claim 53.

Claims 7 and 18 are objected to for depending from canceled claims 6 and 17 respectively. Please correct.

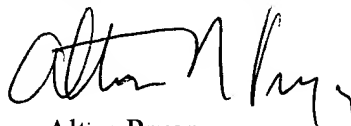
Telephonic Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alton Pryor whose telephone number is (703) 308-4691. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jose Dees, can be reached on (703) 308-4628. The fax phone number for this Group is (703) 308-4556.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.



Alton Pryor

Primary Examiner, A

ALTON N. PRYOR
PRIMARY EXAMINER

3/29/03